



402-038-26

2FW
AF/2839

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy : Examiner: N. Abrams
Serial No. 10/085,502 : Group Art Unit: 2839
Filed: February 27, 2002 :
Title: Modular Electrical Connector :
System :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Box AF

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Applicant respectfully requests reconsideration of the final rejection of Claims 17 and 20 made in the Official Action dated April 23, 2004.

In the Final Action, Claims 17 and 20 were rejected as being obvious under 35 U.S.C. Section 103(a) over the Wise patent in view of the Electri-Pak Publication and the McCarthy patent. Applicant respectfully disagrees with this basis for prior art rejection.

**I hereby certify that this correspondence is
being deposited with the United States Postal Service
as first class mail in an envelope addressed to
Commissioner for Patents, P.O. Box 1450, Alexandria,
VA 22313-1450, on the date indicated below.**

Mark P. Stone 6/29/04
MARK P. STONE (Date of Deposit)
Reg. No. 27,954

In a Request For Reconsideration filed on March 18, 2004, Applicant presented arguments against the same prior art rejection now repeated in the Final Action. Applicant incorporates by reference herein the specific arguments previously advanced in the Request For Reconsideration filed on March 18, 2004. In essence, the disclosures of the three applied prior art references teach different combinations of electrical circuitry and electrical distribution systems formed from different arrangements of the disclosed electrical circuitry. However, for the reasons more specifically addressed by Applicant during the prosecution of this patent application, neither of the three applied references, either individually or in combination, teach or disclose the electrical distribution systems, including the specific arrangement of electrical circuitry, as defined by Claims 17 and 20.

In the latest Official Action, the Examiner responds to Applicant's arguments by stating, among other things "...it would have been obvious to try other arrangements..." of the electrical circuitry disclosed by the prior art references. It is axiomatic that "obvious to try" or "obvious to experiment" is not the standard for determining patentability of claims. See, for example, In re Dow Chemical Co., 5 USPQ 2d 1529 (Fed. Cir. 1988) in which the Court reiterated that "obvious to experiment" is not a proper standard for determining obviousness under 35 U.S.C. Section 103, and that there must be a reason or suggestion in the

prior art itself for combining the references, other than based upon knowledge from the Applicant's own disclosure. See, also Gillette Co. v. S.C. Johnson & Son, 16 USPQ 2d 1923 (Fed. Cir. 1990) and Ecolchem, Inc. v. Southern California Edison Co., 56 USPQ 2d 1065 (Fed. Cir. 2000) in which the Court again stated that "obvious to try" is not the standard of patentability, and is not to be equated with obviousness under 35 U.S.C. Section 103.

In the latest Official Action, the Examiner has also based the rejection of Claims 17 and 20 on the grounds that "...No specific problem is shown to be solved by the recited invention over the Wise system...", and that no unexpected result would be produced by modifying the Wise patent to conform to the electrical distribution systems specifically defined by Applicant's Claims 17 and 20. Applicant respectfully disagrees with this basis for rejection. In the first instance, the statements that Applicant's invention does not solve a specific problem and that no unexpected results are attained by Applicant's claimed system, are conclusory statements which are not supported by the prior art itself. More importantly, although the showing of a solution of problem in the art, or of unexpected results derived from an invention may constitute evidence of patentability of an invention, there is no legal requirement that the showing of the solution of a problem or unexpected results is a necessary pre-requisite to the patentability of claims. See, for example, Panduit Corp. v.

Dennison Mfg. Co., 1 USPQ 2d 1593 (Fed. Cir. 1987) in which the Court stated that there is no requirement that a claimed invention attain an "unexpected result" before a conclusion of non-obviousness may be reached. Similarly in Leinoff v. Louis Milona & Sons, Inc., 220 USPQ 845 (Fed. Cir. 1984), the Court concluded that a long-felt need is not a requirement for the conclusion that an invention is non-obvious.

Applicant respectfully submits that the standards upon which Claims 17 and 20 were rejected in the Final Action, namely that it would have been obvious to try or experiment to attain Applicant's invention, that Applicant's invention does not solve any specific problem, and that no unexpected results derived from Applicant's invention, are not the proper standard for determining the patentability of the claims under 35 U.S.C. Section 103(a). Applicant respectfully submits that the basis for maintaining the prior art rejections of Claims 17 and 20, as set forth in the Final Action, are erroneous as a matter of law.

For the reasons addressed during the prosecution of this patent application, Applicant submits that none of the three applied prior art references, either alone or in combination, teaches or suggests the electrical distribution system and arrangement of circuitry specifically defined by pending Claims 17 and 20 when these claims are considered as a whole, and when the disclosures of each of the three prior art references are considered in their entirety, including teachings contrary to

the system and arrangement of circuitry specifically defined by the pending claims. Applicant submits that there is no teaching or suggestion in the prior art references themselves to both modify and combine the references in any manner rendering the pending claims obvious. On the contrary, as a result of the diverse teachings of the individual references, the only suggestion for combining the references as proposed in the Official Action must be derived from using Applicant's own disclosure as a guide for selectively combining different portions of the different references. However, it is well established that it is improper to use Applicant's own disclosure as a guide for "combining the right references in the right way". On the contrary, references can only be combined to reject a claim if there is a suggestion or motivation in the prior art itself to make the combination. See, for example, Orthopedic Equipment Co. v. United States, 217 USPQ 193 (Fed. Cir. 1983); In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992); Micro-Chemical Inc. v. Great Plains Chemical Co., Inc., 41 USPQ 2d 1238 (Fed. Cir. 1997).

*

*

*

For the reasons discussed above and throughout the prosecution of this application, Applicant submits that Claims 17 and 20 are allowable over the prior art applied in the Final Action, and respectfully requests that the prior art rejections

of the claims made in the Final Action be reconsidered and withdrawn.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Mark P. Stone", written in a cursive style.

Mark P. Stone
Reg. No. 27,954
Attorney for Applicant
25 Third Street, 4th Floor
Stamford, CT 06905
(203) 329-3355